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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/660,706 Confirmation No. : 7679
First Named Inventor : Stephen RICKER
Filed : September 12, 2003
TC/A.U. : 3677
Examiner : Flemming SAETHER

Docket No. : 011357.52664US
Customer No. : 23911

Title : HYDRAULIC NUT

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the provisions of the Pre-Appeal Brief Conference Pilot Program effective June 25, 2005, Applicant requests a review of the final rejection of claims 1-26. This request is being filed with a Notice of Appeal. No amendments are being filed with this request.

Claims 1-14 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Kellstroem (U.S. Patent No. 5,779,419) in view of Reeves (U.S. Patent No. 5,660,417). Claims 15-26 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Kellstroem in view of Reeves and further in view of Shappard (U.S. Patent No. 4,411,549).

According to the Examiner, the combination of Kellstroem and Reeves discloses every limitation of Claims 1-14, and the combination of Kellstroem, Reeves and Shappard discloses every limitation of Claims 15-26. Specifically, the Examiner contends, among others, that "it would have been obvious for one of

ordinary skill in the art to provide the device of Kellstroem with a separate protrusion for the displacement bar as disclosed in Reeves in order to make the device more versatile by providing for different displacement bar configuration not requiring the specialized gauge currently employed by Kellstroem.”

Applicant respectfully submits that this rejection is legally deficient because the Examiner has not established a prima facie case of obviousness. The Manual of Patent Examining Procedure (MPEP) requires that in order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *MPEP* §2143 (8th ed., Rev. 4, October 2005). In the present case, the Examiner fails to mention, let alone to establish, where the alleged motivation or suggestion can be found in the references or in the knowledge generally available to one of ordinary skill in the art.

Although the above discussion is sufficient to establish that the rejection is legally deficient, Applicant wishes to add that the motivation cannot be found to combine the teachings of Kellstroem and Reeves as suggested by the Examiner. The device of Kellstroem is used to mount a bearing on a conical seating, while the device of Reeves is used to maintain a leak-free joint. One with ordinary skill in the art, reading the two references, would not be motivated to combine their teachings as suggested by the Examiner.

In addition to the above-discussed clear legal deficiency, there are also clear factual deficiencies in the rejection. For example, contrary to the Examiner's contention, Kellstroem does not disclose the claimed limitation of a “displacement bar having a length $L = T + a$ where ‘a’ is a predetermined distance for axial movement of said piston.” This limitation requires that it is possible for an end face (40) of the displacement bar (26) to be flush with a side face (42) of the nut body (12).

In Kellstroem, the measuring pin (19) of the measuring device (20), which the Examiner considers to be equivalent to the displacement bar of the claimed

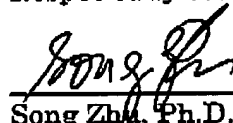
invention, is not designed to be flush with a side face of the nut body (9), because this would separate the measuring pin (19) from the distance measuring device (20), either damaging the distance measuring device (20) or rendering it inoperable. The measuring pin (19) forms part of the distance measuring device (20) (see Kellstroem at column 3, lines 32-37). *MPEP* §2143.01 (8th ed., Rev. 4, October 2005) (a proposed modification cannot render the prior art unsatisfactory for its intended purpose).

For the reasons stated below, Applicant respectfully submits that there are clear legal and factual deficiencies in the rejections.

The Commissioner is hereby authorized to charge any necessary fees in connection with this Request to Deposit Account No. 05-1323 (Docket No.: 011357.52664US).

Respectfully submitted,

December 22, 2005



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